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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Dusan Bartsch et al.

Serial No. : 08/656,811 Examiner: Krikorian, J.

Filing : June 3, 1996 Group Art Unit: 1818

For : METHOD FOR ENHANCING LONG-TERM MEMORY IN A SUBJECT AND USES THEREOF

1185 Avenue of the Americas
New York, New York 10036
July 22, 1997

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

COMMUNICATION IN RESPONSE TO JULY 8, 1997 OFFICE ACTION

This Communication is submitted in response to a July 8, 1997 Office Action issued in connection with the above-identified patent application by the United States Patent and Trademark Office. A response to the July 8, 1997 Office Action is due August 8, 1997. Accordingly, this Communication is being timely filed.

On page 2 of the July 8, 1997 Office Action, the Examiner to whom this application has been assigned has required a restriction to one of the following allegedly patentably distinct inventions:

Group I Claims 1-6 and 15-22, drawn to a method to enhance long term memory and of treating a subject with long term memory defect, using a compound that interferes with binding of a cAMP-response-element-binding protein-2 to a protein or DNA;

Group II Claims 7-14, drawn to a method of evaluating the ability of a compound to interfere with binding of a cAMP-response-element-binding protein-2 to a protein or DNA;

Group III — Claim 23, drawn to recombinant eukaryotic cell comprising DNA encoding cAMP-response-element-binding protein-2;

Group IV — Claim 24, drawn to a transgenic, nonhuman mammal, whose somatic and germ cells contain and express a DNA encoding a cAMP-response-element-binding protein-2;

Group V — Claims 25-27, drawn to a pharmaceutical composition comprising an effective amount of a compound capable of interfering with binding of a cAMP-response-element-binding protein-2.

The Examiner stated inventions III-V are related as products and that the products claimed are distinct because they are made by different methods, have different structures, and have distinct functional properties. For example, the Examiner stated, the cell of Group III is a different class of product from the mammal of Group IV and the compound of Group V. Thus, the Examiner stated, the inventions are deemed patentable distinct.

The Examiner stated that inventions V and (I-II) are related as product and process of use. The Examiner further stated that in the instant case, the pharmaceutical composition comprising a compound capable of interfering with a cAMP-response-element-binding protein-2 (Group V) can be used in a materially different manner from that claimed, such as to identify the cAMP-response-element-binding protein-2 in an assay. The Examiner stated that the methods of Groups I-II do not use the products of Group III and IV.

The Examiner stated that inventions I-II are related as processes of use. The Examiner further stated that the inventions are independent and distinct because they are materially different methods, involving different steps, reagents, issues, and

objectives.

The Examiner stated that if applicants elect Group I, then applicants are required to elect a compound species among the following species:

Species A	antibody to cAMP-response-element-binding protein-2 (claims 2, 17);
Species B	organic compound (claims 4, 19);
Species C	peptide or peptide mimetic (claims 4, 19);
Species D	small molecule (claims 4, 19); or
Species E	nucleic acid (claims 4, 19).

The Examiner stated that the species are distinct from each other because they are different classes of molecules with different structures, and are made by different methods. For example, the Examiner stated, a nucleic acid is made up of nucleotides whereas a peptide is made up of amino acids; a small molecule may be inorganic, and an organic compound may be a carbohydrate. Thus, the Examiner stated, it is apparent that the species are distinct.

The Examiner further stated that applicants are required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. The Examiner stated that currently, claims 1, 3, 5, 6, 15, 16, 18, and 20-22 are generic.

The Examiner stated that if applicants elect Group II, then applicants are required to elect a compound species from among the following:

Species A	antibody to cAMP-response-element-binding protein-2 (claims 8, 12);
Species B	organic compound (claims 10, 14);
Species C	peptide or peptide mimetic (claims 10, 14);
Species D	small molecule (claims 10, 14); or
Species E	nucleic acid (claims 10, 14).

The Examiner stated that applicants are advised that a response to the requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. The Examiner further stated that an argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

In response, applicants elect with traverse Group I, claims 1-6 and 15-22 drawn to a method to enhance long term memory and of treating a subject with long term memory defect, using a compound that interferes with binding of a cAMP-response-element-binding protein-2 to a protein or a DNA. Applicants further elect species D) small molecule (claims 4,19).

However, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine Groups I-V together in view of the following remarks. 35 U.S.C. § 121 states "[i]f two or more independent *and* distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions" (emphasis added). Applicants maintain that the claims of Groups I-V are dependent (related) inventions. In defining the term "related," the M.P.E.P. states, "the term 'related' is used as an alternative for 'dependent' in referring

to subjects other than independent subjects." M.P.E.P. § 802.01. Groups I-V are dependent since all involve products and process of use of compounds which inhibit binding of cAMP-response-element-binding protein-2 to a protein or a DNA. Applicants contend that the Groups I-V are not independent since they each are related to cAMP-response-element-binding protein-2. Therefore, applicants respectfully assert that two or more independent and distinct inventions have not been claimed in the subject application because the groups are not independent under M.P.E.P. § 802.01. Accordingly, applicants contend that restriction is improper under 35 § U.S.C. 121.

Further, applicants respectfully point out that under M.P.E.P. § 803, the Examiner must examine the application on the merits, even if it includes claims to distinct inventions, if the search and examination of an application can be made without serious burden. There are two criteria for a proper requirement for restriction, namely: (1) the invention must be independent and distinct; and (2) there must be a serious burden on the Examiner if restriction is not required. Applicants contend that there would not be a serious burden on the Examiner if restriction is not required. This is so because a search of the prior art for subject matter defined by claims in any one of Groups I-V would necessarily overlap and possibly identify art pertaining to the subject matter defined by claims in any of the other Groups. For example, a search of the prior art for a method to enhance long term memory using a compound that interferes with binding of a cAMP-response-element-binding-protein-2 (Group I) would necessarily overlap and possibly identify art pertaining to a method of evaluating the ability of a compound to interfere with binding of a cAMP-response-element-binding-protein-2 to a protein or a DNA (Group II) and to a pharmaceutical composition comprising an effective amount of a compound capable of interfering with binding of a cAMP-response-element-binding-protein-2 (Group V). Therefore, it would not be a serious burden for the Examiner to examine all of the groups (Groups I-V)

together. Accordingly, in view of the foregoing remarks, applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement and examine all of the claims in Groups I-V together, namely claims 1-27.

If a telephone interview would be of assistance in advancing the prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

No fee is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents Washington, D.C. 20231

7/22/97
John P. White Date
Reg. No. 28,678